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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,222	12/20/2001	Ranjani V. Parthasarathy	57314US002	9052

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3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/027,222	Applicant(s) PARTHASARATHY ET AL.	
	Examiner Dwayne K Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42,44,45 and 53-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-42,44,45 and 53-65 is/are rejected.
- 7) ☒ Claim(s) 55-63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/4/2004, 5/6/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant has requested that independent claims 1-2, 17-18, 20-21 and 36 be examined and rejoined with the remaining claims upon an indication of allowable subject matter in examined claim 39. Since the Examiner has not indicated allowable subject matter in claim 39, the claims remain restricted and unexamined.

Claim Objections

2. Claims 55-63 were previously objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. **Please see Response to Arguments below**

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 39-42, 44, 45 and 54-63 were provisionally rejected in a previous Office Action under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53 and 56-61 of copending Application No. 10/417,609. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. **This rejection remains in effect.**

Claims 39-42 and 54-63 were also provisionally rejected in a previous Office Action under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 50-53 of copending Application No. 10/272,226 in view of Nelson et al. (6,344,326). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. **This rejection also remains in effect.**

The Examiner notes applicant's desire to address these rejections upon an indication of otherwise allowable subject matter (page 6 of submission dated 5/6/2004).

Inventorship

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 39-41, 44, 45 and 53-65 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (6,344,326) in view of Gjerde et al. (6,265,168).

Claim 42 was previously rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (6,344,326) and Gjerde et al. (6,265,168) as applied above, and further in view of Mian (6,319,469).

These rejections remain in effect. Please see Response to Arguments below.

Response to Arguments

8. Applicant's arguments filed 5/4/2004 have been fully considered but they are not persuasive. In traversing the Examiner's arguments, applicant appears to be relying on the argument that there would be no motivation to combine Nelson and Gjerde since the two references utilize different elution methods in removing the compounds from the trapping matrix and that, in fact, Gjerde teaches away from Nelson. The Examiner respectfully disagrees. The issue in combining the two references is not what is done with the trapped molecules after they have been trapped on the solid phase material, but the selection of the media to be used. It was stated in paragraph 16 of the Office Action dated 7/3/2003 that the reason for combining the media from Gjerde with the device of Nelson was to obtain the benefit of the quantitative adsorption and desorption of varying lengths of short- and long-chain nucleic acids" that can be turned on and off through the proper combination of matrix materials as described in Gjerde et al." This benefit would still be present and obtainable regardless of the methods used to elute the compounds from the trapping matrix. Therefore, the Examiner believes that the motivation for combining the two references is proper since the use of Gjerde's media would provide for the benefit of a greater number of compounds being trapped quantitatively as cited above. Also, the Examiner believes that use of Gjerde's media

would actually refine the use of Nelson since it would allow for the quantitative separation of a greater number of nucleic acid chains.

As to the objection of claims 55-63, the Examiner believes he is still correct in objecting to the claims as not further limiting the parent claim. The claims in question depend on claim 39 which does not actually claim the biological sample. This would require the claiming of a kit or combination. Instead, applicant has claimed a device. A device – as noted by applicant - for containing a biological sample but not the sample itself. Therefore, a limitation placed on the biological sample does not limit the device itself but instead limits what may be examined or used with the device. It is for this reason that the Examiner objects to the claims as not limiting the parent claim.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
July 26, 2004



ARLEN SODERQUIST
PRIMARY EXAMINEE